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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,388	05/03/2001	Ulrich Annen	251.82B	9482

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EXAMINER

ANTHONY, JOSEPH DAVID

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 03/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/849,388

Applicant(s)

Examiner

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 5/3/01 as pre-amendments A & B
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-36 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-36 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper N (s) _____
- ☒ Notice of Reference(s) Cited, PTO-892 (Filed by applicant from previous cases)
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-848
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

Election/Restriction

1. No restriction has made in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. None.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4, 12, 21, and 34-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Dependent claims 4, 12, and 21 are deemed to be indefinite because the concentration of a compound of Formula I can not equal 100% by weight, which the claims now read on, since these

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claims are dependent on base independent claims which are drawn to a composition. A composition by definition has more than just one component.

Claim 34 is indefinite because it is drawn to a process for preparing a compound of Formula I as found in claim 1. Yet claim 1 is drawn to a substantially solid composition not to a compound of Formula I.

Claims 35-36 are being rejected here because they contain all the limitations of the dependent claim(s) from which they depend, and these said dependent claims are rejected for the reasons given above.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hart et al., "Some New Quaternary-Substituted Alkyl Morpholinium Chlorides And Pyrrolidinium Alkyl Sulfates", Journal of Organic Chemistry, 22:1 (March 5, 1957), pp. 86-88, in view of Banasiak et al. U.S. Patent Number 4,737,498.

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Harts' example III teaches the species N-hexadecyl morpholinium acetonitrile chloride that is encompassed by applicants' Formula I. Hart et al discloses that such compounds are intended to be used as bactericides. Please note that the other reaction components, such as solvents, reactants and products and byproducts are all deemed to supply another component such that the Harts' invention reads on a composition.

Hart et al differs from applicants' claimed invention in the following ways: 1) Hart et al does not directly disclose the use of N-hexadecyl morpholinium acetonitrile salts in combination with other conventional components used to make conventional fungicides/bactericides formulations, and 2) Hart et al does not directly disclose N-alkyl ammonium acetonitrile salts wherein the said salts have counterions selected from the group consisting of sulfate, bisulfate, tosylate or mixtures of bisulfate and sulfate, as set forth in applicant's independent claims 10 and 20.

Banasiak et al discloses N-alkyl-2,6-dimethylmorpholinocarboxamide salts as effective fungicides and bactericide, see the abstract, and column 5, lines 58-61. Banasiak et al directly discloses that the disclosed fungicides/bactericides (i.e. the active ingredients) can be made into conventional formulations such as solutions, emulsions, powders, granules etc., see column 6, lines 42-50. The said formulations are made in conventional ways, see column 6, lines 52-68. Specific of suitable solid carrier are clays, silica, alumina, silicates, see column 7, lines 4-15. Other additives such as emulsifiers, carboxymethyl cellulose, acids etc. can also be incorporated into such formulations, see column 7, lines 15-45. The said formulations comprise from 0.1 to 95 % by

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weight the active ingredient, see column 7, lines 47-49. Finally, the formulations can comprise additional active ingredients such as other fungicides, bactericides, insecticides, etc, see column 7, lines 55-68.

It would have been obvious to one having ordinary skill in the art to use the disclosure of Banasiak et al as motivation to formulate the bactericides, as taught by Hart et al, into conventional formulations so as to make a composition since such conventional formulations are directly taught by Banasiak et al..

It would also have been obvious to one having ordinary skill in the art to use the disclosure of Banasiak et al as motivation to formulate bactericides, as taught by Hart et al, wherein the counterion of the said bactericides is selected to be sulfate in leu of chloride as directly disclosed by Hart et al. This is obvious because Banasiak et al discloses that sulfate ions are generally the functional equivalent to chloride ions as counterions for bactericides/fungicides.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-30 and 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent Number 6,183,665.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims are deemed to extensively overlap the claimed subject matter of the patented claims. Please note that claim 9 of U.S. Patent Number 6,183,665 directly claims that the counterion is sulfate, bisulfate, methylsulfate or tosylate.

10. Claims 1-30, and 33 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,888,419. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap each other extensively in scope. Please note that claim 8 of U.S. Patent Number 5,888,419 directly claims that the counterion is sulfate, bisulfate, methylsulfate or tosylate.

11. Claims 1-30 and 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5,958,289. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are deemed to be a very large subset of the pending claims.

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12. Claims 1-30 and 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-26 of U.S. Patent No. 5,741,437. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap each other in scope.

13. Claims 31-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5,739,327. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap each other in scope.

14. Claims 31-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,959,104. Although the conflicting claims are not identical, they are not patentably distinct from each other because overlap each other in scope.

Claims Free Of Prior-Art

15. Claims 1-9, and 31-36 are deemed to be free of any prior-art rejections because the N-alkyl ammonium acetonitrile compounds claimed are deemed to be both novel and unobvious for the reasons as set forth in applicant's Remarks section of Amendment B filed 10/14/99 and as set

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forth in the persecution history of the Grandparent application S.N. 08/475,292 now U.S. Patent Number 5,739,327.

The prior-art rejection made in section 7 above over claims 10-30 could be overcome if applicant were to amend independent claim 10 in line 10 by deleting "C₁₋₂₄" and inserting therefor --C₁₋₈--. Likewise in independent claim 20, line 6 delete "24" and insert therefor --8--. Such amendments would overcome the applied prior-art rejections for claims 10-30 for the same reasons claims 1-9 and 31-36 are presently free of any prior-art rejections.

Prior-art Cited But Not Applied

16. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

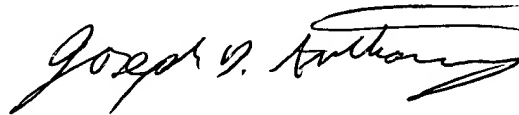
Also note EP 0 790 244 A1 which is deemed to disclose applicants' claimed N-alkyl ammonium acetonitrile species, is not being applied in a rejection over applicants' present claims since it has a publication date of 08/20/97 and is thus not prior-art over the filing date of the present application.

Examiner Information

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (703) 308-0446. This examiner can normally be reached on Monday through Thursday from 7:35 a.m. to 6:00 p.m.

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in the eastern time zone. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The group (**non-after final**) FAX machine number is (703) 872-9310. The group (**after final**) FAX machine number is (703) 872-9311. Unofficial correspondence transmitted by FAX must be marked "DRAFT". All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0651. The receptionist is located on the 8th floor of Crystal Plaza 3 (e.g. CP-3) and will be the welcome point for all visitors to the building.



Joseph D. Anthony
Primary Patent Examiner
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3/22/03